REMARKS

Claims 1-27 are pending. Claims 1-27 currently stand as rejected, and Applicants respectfully request reconsideration of the rejection based upon the following remarks.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,389,477 (the '477 patent) in view of U.S. Patent 4,845,263 (the '263 patent). More specifically, the Examiner asserted that the '477 patent discloses "a photoconductive element for electrophotography that includes a salt of an electron transport compound (claim 33)." The Examiner also asserted that, "it would have been obvious to one of ordinary skill in the art to use the salt derivative of the electron transport compound of [the '263 patent] as the electron transport compound in salt form because of the direct suggestion of [the '477 patent]." Applicants submit that the Examiner has not established a prima facie case of obviousness, and respectfully request reconsideration of the rejection based upon the following comments.

In order to establish a prima facie case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP § 2143. As described in Applicants' specification, "suitable salts of electron transport compounds include, for example, salts comprising a cation and an anion derived from an electron transport compound." See specification at page 4, lines 24-26. In other words, a salt of an electron transport compound is a salt derived from a compound that has electron transport ability. With respect to the '477, claim 33 teaches that the electron transport substance can be selected from the group consisting of "diazo pigments, perylene pigments, anthanthrone pigments, thiapyrylium pigments, thiapyrylium salt derivatives and pyrylium salt derivatives and cyanine derivatives." The only other mention of salts in the '477 patent relates to thiapyrylium salt derivatives and pyrylium salt derivatives. Applicants submit that pyrylium and thiapyrylium are

cations that are not derived from compounds that are not electron transport compounds. For example, the pyrylium cation is a six-membered aromatic ring having an oxygen atom, which can be formed by the following reaction: 

. As such, pyrylium based salts are not salts formed, or derived, from compounds that are electron transport compounds, and therefore are not salts of an electron transport compound as that terminology is used throughout Applicants' specification. Similarly, the thiapyrylium cation has the same structure as the pyrylium cation above, except the oxygen atom is replaced by a sulfur atom, and thus thiapyrylium based salts are not salts derived from compounds that are electron transport compounds. Thus, the thiapyrylium salts disclosed in the '477 patent are not salts of electron transport compounds as that terminology is used throughout Applicants' specification. Additionally, the '477 patent does not explicitly teach or suggest that the thiapyrylium salt derivatives and pyrylium salt derivatives are derived from compounds that have electron transport ability, and therefore one of ordinary skill in the art would not read the '477 patent as teaching or suggesting the use of salts formed from electron transport compounds. Moreover, pyrylium and thiapyrylium compounds are known to be charge generating compounds (i.e., hole transport compounds), not electron transport compounds. See, for example, U.S. Patent Nos. 6,835,512 (column 36, lines 41-50) and 5,183,718 (column 39, lines 55-60). Since the salts disclosed in the '477 patent are not salts of electron transport compounds, and the '477 patent does not suggest the use of salts derived from electron transport compounds, the '477 patent does not teach or suggest all of the features of Applicants claimed invention.

Additionally, the '263 patent does not disclose salts of electron transport compounds, and therefore does not make up for the deficiencies of the '477 patent. In contrast, Applicants invention, as claimed in independent claims 1, 13 and 20, relate to photoconductive element comprising a salt of an electron transport compound. Since the combination of the '477 patent

and the '263 patent does not disclose or suggest this feature of Applicants' claimed invention, the combination of the '477 patent and the '263 patent does not render Applicants' claimed invention prima facie obvious.

Since the combination of the '477 patent and the '263 patent does not render Applicants' invention, as claimed in independent claims 1, 13, and 20, prima facie obvious, Applicants respectfully request withdrawal of the rejection of claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over the '477 patent in view of the '263 patent.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

Brian L. Jarrells
Registration No. 53,067

Customer No. 24113
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 252-1535